

REMARKS

In the non-final office action mailed October 20, 2006, claims 1-14 and 44-69 were pending. Claims 1, 5-7, 11-14, 44-47, 51-57, 60-69 were finally rejected. Claims 2-4, 8-10, 48-50 and 58-59 were apparently withdrawn, although the office action did not list these claims as being either pending or withdrawn in the Office Action Summary. Since these claims have not been cancelled by the applicant, these claims should have been indicated as withdrawn based on their status in the first office action. These withdrawn claims are entitled to reinstatement upon allowance of the claim from which each depends. Reconsideration of the present application in view of the remarks that follow is respectfully requested.

Regarding the withdrawal of claims 8-10, 48-50, 58 and 59, the Examiner believes that these claims do not belong to the elected species and asserts that Applicant never mentions that Figures 3 and 4 belong to the elected species, and on this basis the Examiner withdrew the above-mentioned claims. It is respectfully submitted that it is not the duty of the applicant to set forth the species which the Examiner considers to be present in the application. The Restriction Requirement did not identify Figures 3 and 4 as a separate species, and Applicant was therefore entitled to respond to the Restriction Requirement on the basis that Figures 3 and 4 were not a separate species. Such reliance was justified since Figures 3 and 4 illustrate additional features of the elected species and the application clearly discloses that reduction elements having the features shown in Figs. 3 and 4 can be employed with the elected Species I. *See, e.g.*, page 9, line 20 to page 10, line 8 of the specification.

Furthermore, the Examiner's assertion that "Applicant never mentions that Figs. 3 and 4 (sic) belong to the elected species" is respectfully traversed. In responding to the Restriction Requirement, Applicant did indeed assert that claims 8-10, 48-50 and 58-59 read on the elected species and thus considered that Figures 3 and 4 belonged to the elected species. *See* the "Amendment and Response to Restriction/Election Requirement" dated December 15, 2004, page 7, lines 14-17. Under the scenario set forth by the Examiner, there could be no election of the species identified in the Restriction Requirement that would allow claims 8-10, 48-50 and 58-59 to be examined in the present application. Therefore, it was reasonable to conclude that there was no intention to set forth Figures 3 and 4 as a separate species since Figures 3 and 4 merely illustrate additional features of the elected species. Therefore, the

election of species was proper, claims 8-10, 48-50, 58 and 59 were identified as reading on the elected species, and examination of claims 8-10, 48-50, 58 and 59 is therefore proper and respectfully requested.

Claims 1, 5, 7, 11, 14, 44, 45, 47, 51, 54-56, 61 and 64-69 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,755,797 to Baumgartner. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

Claim 1 recites a system that includes "a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body; voids between respective ones of said plurality of reduction elements; and material filling said voids and locking said plurality of reduction elements relative to one another." Baumgartner fails to material filling voids between respective ones of a plurality of reduction elements. Baumgartner also fails to disclose material filling the voids and locking the elements relative to one another. In Baumgartner, string material 20 is located within the passages formed through support members 7 and extends between adjacent support members 7. However, there is no disclosure that string 20 is configured to fill voids between respective ones of the support members 7 as recited from the material in claim 1. Furthermore, string 20 does not lock the support members 7 relative to one another. Baumgartner discloses string 20 includes stop parts 21 in the form of knots "so that a predetermined minimum distance A is observed between the support members 7 which corresponds at least approximately to the diameter of

one of the support members 7....” See col. 5, lines 30-36. Support members 7 are thus spaced from one another along string 20 and thus freely move relative to one another even when connected with string 20. Thus, Baumgartner also fails to disclose “material filling said voids and locking said plurality of reduction elements relative to one another” as recited in claim 1.

The Office Action asserts that “the Baumgartner reference reads on the claims. For example, the Examiner interpreted the voids as the openings extending from one end to the other end of element structure 7 in Fig. 6 and the string-like material 20 has been interpreted as the filling material filling the voids (see Fig. 6).” However, as discussed above, Baumgartner fails to disclose the elements arranged as recited in claim 1, and in order to “read” Baumgartner on claim 1 it is necessary to add disclosure to Baumgartner that is not present in Baumgartner. Therefore, Baumgartner cannot be properly considered to anticipate claim 1, and withdrawal of this basis of the rejection of claim 1 is respectfully requested.

Furthermore, Baumgartner teaches away from material filling voids between the support members and such would render Baumgartner unsuitable for its intended purpose since “during loading, the support members are elastically deformed, and the compressive forces acting in the direction of the member axis are converted into edges stresses in the annulus fibrosus.” See col. 1, line 62-65. Therefore, claim 1 is allowable.

Claim 44 recites a system that includes “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body; voids between respective ones of said plurality of reduction elements; and material filling said voids and locking said plurality of reduction elements relative to one another.” As discussed above with respect to claim 1, Baumgartner fails to disclose these elements. Nor is Baumgartner properly modifiable to include these elements since Baumgartner teaches away from such a configuration. Therefore, claim 44 is allowable.

Claim 55 is directed to a system that includes “a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue,

wherein said plurality of reduction elements include exterior surface means for facilitating engagement between adjacent reduction elements and for facilitating said reduction elements acting randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body; voids between respective ones of said reduction elements; and material filling said and voids locking said plurality of reduction elements relative to one another." As discussed above with respect to claim 1, Baumgartner fails to disclose these elements. Nor is Baumgartner properly modifiable to include these elements since Baumgartner teaches away from such a configuration. Therefore, claim 55 is allowable.

Claims 5, 7, 11, 14, 45, 47, 51, 54, 56, 61 and 64-69 depending from claims 1, 44 and 55 that were rejected as being anticipated by Baumgartner are allowable at least since the claim from which each depends is allowable and for other reasons. For example, claim 65 depends from claim 1 and recites "wherein said reduction elements rigidly engage one another." The Office Action provides no indication of where this feature is disclosed in Baumgartner, and therefore has not provided a prima facie case for rejecting claim 65. Furthermore, as set forth above, it is clear that Baumgartner discloses an arrangement where the elements elastically engage one another. In another example, claim 66 depends from claim 1 and claim 68 depends from claim 44. Claims 66 and 68 recite "further comprising means for rigidly fixing said plurality of reduction elements in the intravertebral space for post-operative maintenance of the reduction of the vertebral body." The Office Action again provides no indication of where these features and recited function are disclosed in Baumgartner, and therefore has not provided a prima facie case for rejecting either of claims 66 or 68. Claims 67 and 69 depend from claims 1 and 44, respectively, and each recites "wherein said plurality of reduction elements are selected to occupy sufficient intravertebral space to restore a height of the vertebral body between endplates thereof." Again, there is no indication of how these features are disclosed in Baumgartner, and therefore a prima facie case for rejecting either of claims 67 or 69 has not been established. Furthermore, Baumgartner discloses the plurality of elements is selected to occupy an intervertebral spacer.

Therefore, withdrawal of the rejection of dependent claims 5, 7, 11, 14, 45, 47, 51, 54, 56, 61 and 64-69 is respectfully requested.

Claims 6, 46 and 57 were rejected as being obvious in view of Baumgartner alone. The Examiner asserts it would have been an obvious matter of design choice to modify the Baumgartner reference to teach claims 6, 46, and 57. However, Baumgartner teaches an implant that provides an elastic support structure formed by the elastic elements so that "during loading, the support members are elastically deformed, and the compressive forces acting in the direction of the member axis are converted into edge stresses in the annulus fibrosus." The use of materials which do not provide an elastic support structure runs counter to the teaching of Baumgartner. The Examiner has not provided any reference that teaches or suggests the desirability of the modification to Baumgartner as proposed by the Examiner. Rather, it appears that the Examiner has used the teachings in Applicant's specification in the present application to modify Baumgartner because the Examiner asserts that "Applicant has not disclosed that the PMMA material provides an advantage, is used for a particular purpose, or solves a stated problem" in asserting that it would have been obvious to employ such materials in Baumgartner. However, the present application is not a proper reference that can be employed to modify Baumgartner to support an obviousness rejection. If the teaching in Applicant's own specification has not been relied upon, then citation of a reference that teaches or suggests the desirability of modifying Baumgartner to teach or suggest claims 6, 46 and 57 is respectfully requested. Alternatively, if the rejection is based on facts within the personal knowledge of the Examiner, then an affidavit providing the same is requested so the rejection can be considered and traversed if appropriate.

Claims 12, 13, 52, 53, 60, 62 and 63 were rejected as being unpatentable over Baumgartner in view of U.S. Patent No. 6,620,196 to Trieu. Claims 12 and 13 depend from claim 1, claims 52 and 53 depend from claim 44, and claims 60, 62 and 63 depend from claim 55. Accordingly, claims 12, 13, 52, 53, 60, 62 and 63 are allowable at least because the claim from which each depends is allowable as asserted herein above.

Reconsideration of the present application including claims 1-14 and 44-69 in view of this response is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted

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